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EXAMINER

TRAN, PHILIP B

ART UNIT

PAPER NUMBER

2155

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11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/191,277**

Applicant(s)  
**Matsuda Et. Al.**

Examiner  
**Philip B. Tran**

Art Unit  
**2155**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 15, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 12-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 12-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

***Response to Amendment***

1. This office action is responsive to the amendment filed on October 15, 2001. Claims 8-11 have been canceled without prejudice. Claims 1, 12, and 29 have been amended. Therefore, pending claims 1-7 and 12-30 are presented for further examination.

***Response to Arguments***

2. Applicants' arguments have been fully considered but they are not persuasive.

A/ Applicants argued that the cited prior art (Lister et al, U.S. Pat. No. 6,167,446) teaches away from the claimed invention.

In response to applicants' arguments, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it.

***Colman v. Kimberly-Clark Corp., 218 USPO 789.***

Applicants' arguments are not found persuasive. Claims 1 and 12 are taken as examples for illustration purpose. Lister teaches a method of initializing a device on a network comprising requesting configuration information from a remote device coupled to the network in response to connecting the device to the network, waiting a period of time for a response to the request for configuration information, providing configuration services to the network if the response to the configuration information request is not received from the remote device within said period of time, and monitoring the network to detect a connection of an additional device to the network

(i.e., providing automatic configuration and establishing and monitoring connections of clients to the server through the network) [see Abstract and Fig. 1, and Col. 3, Line 39 - Col. 4, Line 67]. Lister does not explicitly teach providing the configuration services to the network if the device has a higher priority than the remote device. However, the task of comparing the priority between one device to another is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to determine the priority of devices connected to the network in order to identify the appropriate states of devices in the network before making decision of whether or not necessarily to provide configuration service. In addition, Lister further teaches a method of initializing a network comprising automatically assigning an address to a device on the network, automatically assigning a network name to the device on the network, automatically supplying user and group information across the network, and automatically determining service capability of the device on the network (i.e., automatic configuration of network addresses and names, and identifying specific resources that are shared between client and server, and determining device on the network for which is assigned to respond to network-file-service s protocol requests) [see Col. 4, Line 14 - Col. 5, Line 39 and Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64]. Moreover, Lister further teaches maintaining a DRS database to track a client list, a proxy site , an alias name and a source server in an automatic operating mode [see Col. 9, Lines 29-65].

As a result, Lister does disclose a method for initializing and configuring device on the network as broadly claimed by the applicants. In other words, applicants clearly have failed to identify specific claim limitations which would define a patentable distinction over Lister.

Therefore, the examiner asserts that Lister teaches or suggests the subject matter broadly recited in independent claims 1, 12, 21, 26 and 29. Claims 2-7, 13-20, 22-25, 27-28, and 30 are also anticipated or obvious at least by virtue of their dependency on independent claims and by other reasons set forth in the previous office action [see Paper No. 8]. Accordingly, rejections for claims 1-7 and 12-30 are presented.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 12, 17-19, 26, and 29-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lister et al (Hereafter, Lister), U.S. Pat. No. 6,167,446.

Regarding claim 12, Lister teaches a method of initializing a network comprising automatically assigning an address to a device on the network, automatically assigning a network name to the device on the network, automatically supplying user and group information across the network, and automatically determining service capability of the device on the network (i.e., automatic configuration of network addresses and names, and identifying specific resources that are shared between client and server, and determining device on the network for which is assigned to respond to network-file-service s protocol requests) [see Col. 4, Line 14 - Col. 5, Line 39 and Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64].

Regarding claim 17, Lister further teaches correlating the network address and the network name, and storing the correlated network address and the correlated network name in a table (i.e., automatic configuration of network addresses and names) [see Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64].

Regarding claim 18, Lister further teaches the network name is suggested by the device [see Abstract].

Regarding claim 19, Lister further teaches HyperText Transfer Protocol (HTTP) is used to exchange information [see Col. 6, Lines 59-67].

Claims 26 and 29 are rejected under the same rationale set forth above to claim 12.

Regarding claim 30, Lister further teaches pushing clients to a resource locator to inform the clients of services provided by a new device [see Figs 1-5].

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-7, 13-16, 20-25, and 27-28 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lister et al (Hereafter, Lister), U.S. Pat. No. 6,167,446.

Regarding claim 1, Lister teaches a method of initializing a device on a network comprising requesting configuration information from a remote device coupled to the network in response to connecting the device to the network, waiting a period of time for a response to the request for configuration information, providing configuration services to the network if the response to the configuration information request is not received from the remote device within said period of time, and monitoring the network to detect a connection of an additional device to the network (i.e., providing automatic configuration and establishing and monitoring connections of clients to the server through the network) [see Abstract and Fig. 1, and Col. 3, Line 39 - Col. 4, Line 67]. Lister does not explicitly teach providing the configuration services to the network if the device has a higher priority than the remote device. However, the task of comparing the priority between one device to another is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to determine the priority of devices connected to the network in order to identify the appropriate states of devices in the network before making decision of whether or not necessarily to provide configuration service.

Regarding claim 2, Lister further teaches providing the configuration services comprises automatically determining a first network address, automatically assigning a second network address, automatically assigning a network name, automatically correlating the first network address, the second network address, and the network name, and recording the correlated first network address, the correlated second network address and the correlated network name in a table (i.e., automatic configuration of network addresses and names) [see Col. 9, Lines 29-60 and Col. 17, Lines 15-31, and Col. 18, Lines 43-64].

Regarding claim 3, Lister further teaches a media access control (MAC) address [see Col. 18, Lines 50-54].

Regarding claim 4, Lister further teaches an Internet Protocol (IP) address [see Col. 17, Lines 22-26].

Regarding claim 5, Lister further teaches assigning the network name comprises detecting a network name conflict, resolving the network name conflict, and recording a code in the table to indicate the network name conflict [see Abstract and Col. 4, Lines 45-57 and Col. 8, lines 45-53].

Regarding claim 6, Lister further teaches the network name is suggested by the first device [see Abstract].



Regarding claim 7, Lister further teaches the period of time is varied so as to prevent race conditions [see Col. 10, Lines 47-63].

Regarding claim 13, Lister further teaches supplying user and group information comprises detecting when the device is connected to said network, sending a first user and group list to the device in response to the device connecting to the network, receiving a more recent user and group list from said device, updating the user and group information to reflect the more recent user and group list, and propagating the updated user and group information throughout the network (i.e., providing automatic configuration and establishing and monitoring connections of clients to the server through the network) [see Abstract and Fig. 1, and Col. 3, Line 39 - Col. 4, Line 67]. Lister does not explicitly teach comparing the first user and group list with a second user and group list resident on the device and determining whether the first user and group list or the second user and group list is more recent. However, the task of comparing the priority between one device to another is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to determine the priority of devices connected to the network for the same reasons set forth above to claim 1.

Regarding claims 14-16, Lister does not explicitly teach a time-stamp is used to determine whether the first user and group list or the second user and group list is more recent, updating the user and group information comprises recording the more recent user and group list in clear text, updating the user and group information comprises encrypting the user and group

information prior to transmission across the network. However, the use of time-stamp and encryption is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement time-stamp for determining the status of data changing with time and to provide encryption process in order to protect data routing through the network.

Regarding claim 20, Lister does not explicitly teach the Service Location Protocol (SLP) is used to exchange information. However, the use of service location protocol is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement service location protocol because it would have enabled the users to locate servers and other network devices connected to the network.

Claim 21 is rejected under the same rationale set forth above to claim 1.

Regarding claim 22, Lister further teaches the first device is a networked office appliance [see Abstract and Col. 6, Lines 1-54].

Claim 23 is rejected under the same rationale set forth above to claim 2.

Claim 24 is rejected under the same rationale set forth above to combination of claims 3 and 5.

Claim 25 is rejected under the same rationale set forth above to claim 4.

Claims 27-28 are rejected under the same rationale set forth above to combination of claims 14-16.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).


A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 746-7239.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh, can be reached on (703) 305-9648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PBT  
Philip Tran  
Art Unit 2155  
December 20, 2001

  
DAVID WILEY  
PRIMARY EXAMINER